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OFFICE OF PETITIONS

In re Application of :
Mark A. Michalicek :
Application No. 10/690,159 :
Filed: October 16, 2003 :
Attorney Docket No. AFD 625 :

ON PETITION

This is a decision on the renewed petition under 37 CFR 1.137(a), filed December 23, 2005, to revive the above-identified application.

The renewed petition under 37 CFR 1.137(a) is **DISMISSED**.

Any request for reconsideration or petition under 37 CFR 1.137(b) must be submitted within TWO (2) MONTHS from the mail date of this decision. Extension of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C § 704.

The above-identified application became abandoned for failure to reply to the non-final Office action mailed April 8, 2005, which set a statutory period for reply of one (1) month from its mailing date. Extensions of time for reply pursuant to 37 CFR 1.136(a) was available. A proper response was not received within the allowed period, and the application became abandoned on May 9, 2005. A petition under 37 CFR 1.137(a) was filed on October 24, 2005, and dismissed by a decision mailed November 2, 2005.

A grantable petition under 37 CFR 1.137(a)¹ must be accompanied by: (1) the required reply,² unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer required by 37 CFR 1.137(c).

¹ As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

² In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

The instant petition lacks item (3).

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

“In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner’s interpretation of those provisions is entitled to considerable deference.”³

“[T]he Commissioner’s discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant’s delay in prosecuting the application was unavoidable, and that the Commissioner’s adverse determination lacked **any** basis in reason or common sense.”⁴

“The court’s review of a Commissioner’s decision is ‘limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.’”⁵

“The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency.”⁶

The standard

“[T]he question of whether an applicant’s delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account.”⁷ The general question asked by the Office is: “Did petitioner act as a reasonable and prudent

³*Rydeen v. Quigg*, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), *aff’d without opinion* (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing *Morganroth v. Quigg*, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); *Ethicon, Inc. v. Quigg* 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) (“an agency’ interpretation of a statute it administers is entitled to deference”); see also *Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc.*, 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) (“if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency’s answer is based on a permissible construction of the statute.”)

⁴*Commissariat A L’Energie Atomique et al. v. Watson*, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

⁵*Haines v. Quigg*, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing *Camp v. Pitts*, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. §706 (2)(A)); *Beerly v. Dept. of Treasury*, 768 F.2d 942, 945 (7th Cir. 1985); *Smith v. Mossinghoff*, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

⁶*Ray v. Lehman*, 55 F.3d 606, 608, 34 U.S.P.Q2d (BNA) 1786 (Fed. Cir. 1995) (citing *Motor Vehicles Mfrs. Ass’n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

⁷*Id.*

person in relation to his most important business?"⁸ Nonawareness of a PTO rule will not constitute unavoidable delay.⁹

Application of the standard to the current facts and circumstances

In the instant petition, petitioner maintains that the circumstances leading to the abandonment of the application meet the aforementioned unavoidable standard and, therefore, petitioner qualifies for relief under 37 CFR 1.137(a). Petitioner argues that a reply to the non-final Office action was mailed on April 28, 2005, accompanied by a certificate of mailing of the same date, but apparently not received by the Office.

With regard to item (3) above, petitioner has again failed to satisfy the requirements of item (3) above because, notwithstanding petitioner's assertion to the contrary, a certificate of mailing dated April 28, 2005, was not found on, or with, the election meant to be responsive to the non-final Office action, nor did petitioner provide a copy of a certificate of mailing dated April 28, 2005, with instant petition. With any renewed petition filed, petitioner must provide a copy of the certificate of mailing that allegedly accompanied the election mailed on April 28, 2005.

Petitioner's request for a refund of fee for the instant petition is noted, however, the request cannot be granted. The petition filed October 24, 2005, was filed under 37 CFR 1.137(a); this rule authorizes a fee amount under 37 CFR 1.17(f), which is \$500.00 for a large entity. Petitioner received a decision on the October 24, 2005, petition and also a decision on the instant petition. The fee was, therefore, charged appropriately. Petitioner had the option of filing a petition to withdraw the holding of abandonment under 37 CFR 1.181 for which there is no fee. However, because petitioner filed the petition under 37 CFR 1.137(a), the fee of \$500.00 was required and, since a decision has been made on the petition under 37 CFR 1.137(a), the fee will not be refunded.

Alternatively, petitioner may revive the application based on unintentional abandonment under 37 CFR 1.137(b) (enclosed). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply, the required petition fee (\$1,500.00 for a large entity and \$750.00 for a verified small entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional

⁸See *In re Mattulah*, 38 App. D.C. 497 (D.C. Cir. 1912).

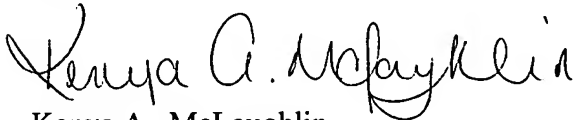
⁹See *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing *Potter v. Dann*, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
United States Patent and Trademark Office
Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3222.

A handwritten signature in black ink, reading "Kenya A. McLaughlin". The signature is written in a cursive, flowing style.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions